

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/082,127	IDEHARA, TAKENORI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dov Popovici	2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE request and the amendment filed on 08/11/2008.
2. ☒ The allowed claim(s) is/are 60-63, renumbered as claims 1-4.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

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|--|--|
| <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br/>Paper No./Mail Date <u>08/11/2008</u></li> <li>4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material</li> </ol> | <ol style="list-style-type: none"> <li>5. <input type="checkbox"/> Notice of Informal Patent Application</li> <li>6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br/>Paper No./Mail Date <u>20080825</u>.</li> <li>7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment</li> <li>8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance</li> <li>9. <input type="checkbox"/> Other _____.</li> </ol> |
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/Dov Popovici/  
 Primary Examiner, Art Unit 2625

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 08/11/2008 has been entered.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 60-63 are, drawn to displaying, when any function has not yet been selected, on the layout image icons of the plurality of input-output apparatuses representing the functions of the plurality of the input-output apparatuses, while, when the one function has been selected, displaying on the layout image icons of the selected functions to represent only the input-output apparatuses that have the selected functions; and assigning a selected one of the input-output apparatuses that are represented on the layout image by the icons as an input or output apparatus for a job, classified in class 358, subclass 1.15.

II. Claims 64-66 are, drawn to displaying a layout image of the plurality of input-output apparatuses; selectably displaying on the layout image names of users of the input-output apparatuses at the locations of the layout image that respectively correspond to actual locations of the users; selectably displaying on the layout image only the input-output apparatuses that relate to the selected user; assigning selected one of the displayed input-output apparatuses as an input or output apparatus for a job, classified in class 358, subclass 1.13.

III. Claims 67-72 are, drawn to (a) determining whether the image forming apparatus is capable of carrying out a job; (b) displaying icons on a layout image, the icons being for output apparatuses that are able to substitute for function(s) of the image forming apparatus to execute the job; (c) automatically selecting an output apparatus that substitutes the functions(s) of the image forming apparatus for the job; (d) distinguishably displaying the icons of the selected output apparatus from the icons of remaining ones of the output apparatuses on the layout image; and (e) allowing a user to select one of the icons corresponding to the remaining ones of the output apparatuses to alter the selected output apparatus; and (f) assigning the selected one of the output apparatuses as a substitution of the image forming apparatus, classified in class 358, subclass 1.14.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as displaying on the layout image icons of the selected functions to represent only the input-output apparatuses that have the selected functions, subcombination II has separate utility such as displaying on the layout image names of users of the input-output apparatus at the locations of the layout image that respectively correspond to actual locations of the users and selectably displaying on the layout image only the input-output apparatuses that relate to the selected user, while subcombination III has separate utility such as determining whether the image forming apparatus is capable of carrying out a job; displaying icons on a layout image, the icons being for output apparatuses that are able to substitute for function(s) of the image forming apparatus to execute the job; automatically selecting an output apparatus that substitutes the functions(s) of the image forming apparatus for the job; distinguishably displaying the icons of the selected output apparatus from the icons of remaining ones of the output apparatuses on the layout image; and allowing a user to select one of the icons corresponding to the remaining ones of the output apparatuses to alter the selected output apparatus; and assigning the selected one of the output apparatuses as a substitution of the image forming apparatus. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

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(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

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inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Douglas A. Sorensen (Reg. # 31,570) on 8/22/2008 a provisional election was made without traverse to prosecute the invention of Group I, claims 60-63. Affirmation of this election must be made by applicant in replying to this Office action. Claims 64-72 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Douglas A. Sorensen (Reg. # 31,570) on 8/26/2008.

The application has been amended as follows:

#### **In the abstract:**

In the abstract, line 4, change "means" to --unit--.

**In the claims:**

Please cancel non-elected claims 64-72.

In claim 60, line 1, after "readable", delete "recording".

In claim 60, line 1, before "program", insert --computer--.

In claim 60, line 4, before "program", insert --computer--.

In claim 61, line 1, after "readable", delete "recording".

In claim 61, line 2, before "program", insert --computer--.

**REASONS FOR ALLOWANCE**

The following is an examiner's statement of reasons for allowance:

The closest prior art of record, namely, Blair et al. (U.S. Patent 5,809,265), Sugiyama et al. (U.S. Patent 5,996,029) and/or Jackson et al "Methodology for Automated Printed Selection" IBM Technical Disclosure Bulletin, vol. 36, no. 09B (September 1993) pp. 379, do not disclose, teach or suggest, displaying, when any function has not yet been selected, on the layout image icons of the plurality of input-output apparatuses representing the functions of the plurality of the input-output apparatuses, while, when the one function has been selected, displaying on the layout image icons of the selected functions to represent only the input-output apparatuses that have the selected functions, as claimed in independent claim 60.

Independent claims 62-63 recite the same or similar claimed limitations, and are therefore found to be allowable for the same or similar reasons.



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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dov Popovici  
Primary Examiner  
Art Unit 2625

/Dov Popovici/  
Primary Examiner, Art Unit 2625